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No. 00-201

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.; THE TIME INCORPORATED MAGAZINE COMPANY; LEXIS/NEXIS and UNIVERSITY MICROFILMS INTERNATIONAL,
Petitioners,

v.

JONATHAN TASINI; MARY KAY BLAKELY; BARBARA GARSON; MARGOT MIFFLIN; SONIA JAFFE ROBBINS; and DAVID S. WHITFORD,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Second Circuit

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QUESTION PRESENTED

Whether a periodical publisher's Copyright Act § 201(c) privilege to reproduce and distribute an author's individually copyrighted article in "any revision of [the periodical issue in which the article originally appeared]" encompasses the privilege to reproduce and distribute such an article (i) as a freestanding work, or (ii) in a new anthology of articles entirely different from the periodical issue in which the article first appeared.

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STATEMENT OF THE CASE

A. Statement of the Facts

1. Respondents Jonathan Tasini, Mary Kay Blakely, Barbara Garson, Margot Mifflin, Sonia Jaffe Robbins, and David S. Whitford are freelance authors. J.A. 67a. Petitioners New York Times Company, Inc., Newsday, Inc., and Time Incorporated Magazine Company (collectively the "Periodical Publishers") publish the New York Times, Newsday, and Sports Illustrated. J.A. 470a, 473a, 474a. Between 1990 and 1993, each of the six Respondents wrote and contributed to those periodicals a total of 21 articles. J.A. 67a-68a.

None of the Respondents was an employee of any of the Periodical Publishers when their contributions to the periodicals were published, and none of the 21 works at issue in this case was written pursuant to a "work for hire" agreement within the meaning of the Copyright Act. J.A. 67a. That being so—and this is undisputed—the copyright in each of the 21 contributions at issue "vest[ed] initially in the author of the contribution," and not in the Periodical Publisher who published the contribution in an issue of its periodical. 17 U.S.C. § 201(c). Given the rulings below and the scope of the Question Presented, it is further undisputed that, while Respondents authorized the Periodical Publishers to include their articles in the periodical publications, none of the individual Respondents entered into any valid contract or licensing agreement with any of the Periodical Publishers that had the effect of divesting or diminishing the Respondents' copyright in the contributed articles.[1]

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[1] In the courts below, there was litigation concerning (i) the lawfulness of Petitioner Newsday's practice of attempting to secure assignments of copyrights from Respondents Tasini, Garson, and Whitford through a legend stamped on the backs of checks issued to those Respondents after their articles had been written and published; and (ii) the scope of a formal

2. The New York Times is a general interest newspaper published daily. J.A. 470a. Each daily edition contains on the order of 200 to 600 separate news and feature articles organized into several topical sections, such as the front page section, the business section, and the sports section. The Sunday edition of the New York Times includes certain sections that do not appear on any other day, including the Book Review section and the Magazine section. J.A. 95a. Each page of each section typically contains several articles, as well as photographs or other pictorial and graphic elements, the arrangement of which is determined by Times editors. *See, e.g.*, Lodged Materials, Vol. II ("L-II"), p.1. Some of the articles in a given edition of the Times are written by paid staff employees of the Times (and therefore are "works made for hire"); other articles are written by freelance authors such as Respondents who have no employment relationship with the Times. J.A. 482a-483a.

Newsday is also a daily general interest newspaper. And, like the New York Times, each edition of the newspaper consists of a number of articles as well as various pictorial and graphic elements. L-II, p.17. The articles in Newsday include both works-for-hire and freelance contributions. J.A. 482a.

Sports Illustrated is a weekly sports magazine, each issue of which contains numerous articles, including both works-for-hire and freelance contributions. J.A. 482a. Sports Illustrated also contains pictorial and graphic elements, including a cover, advertisements, many photographs, and a variety of other non-text features. L-II, pp. 28-33.

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agreement between Respondent Whitford and Time, Inc. concerning the parties' respective rights in a Sports Illustrated article written by Whitford. *See* Pet. App. 3a, 18a. The Second Circuit ruled in favor of Respondents on those issues, and Petitioners have not sought review of those rulings in this Court. *Id.* at 3a n.1, 21a-22a.

3. Petitioners LEXIS/NEXIS and University Microfilms International ("UMI") (collectively the "Electronic Publishers") republish written works in three different electronic forms.

(A) NEXIS

(i) Petitioner LEXIS/NEXIS maintains "NEXIS," a digital database comprised of millions of articles from selected newspapers and periodicals. LEXIS/NEXIS provides individual articles and compilations of articles electronically to subscribers for a fee. J.A. 83a. Pet. App. 3a-4a. The articles in NEXIS originate from, and are licensed from, hundreds of different publications; the three periodicals at issue here constitute a small fraction of the licensing publications. J.A. 216a-328a; Pet. App. 3a-4a.

Each article is stored in the NEXIS database system as an individual file, and each file has its own individual file identifier. J.A. 83a. Each file contains (i) the text of the article as the text appeared in the originating periodical; and (ii) various electronic codes (including author, subject, and other codes, *see infra*) that enable the NEXIS software to cull the article from the mass of articles in the database, to link the article to other articles in the database, and to provide computer displays, printouts, and "downloads" (*i.e.*, electronic copies and transfers) of individual articles and/or groups of articles. J.A. 190a.

At any given time, the contents of NEXIS are fixed and stored in electronic form in a master file made up of the millions of individual files/articles that have been compiled to that point. J.A. 83a-84a. At the same time, additional articles/files are being added to NEXIS at least daily. *See* J.A. 89a. Before those articles/files are made part of the database, an electronic copy is made of the entire pre-existing version of NEXIS, which copy is stored off-line in electronic form and given a designation, such as NEXIS "Generation

100." J.A. 83a. The new and additional articles/files are then "streamed" and merged into that off-line copy one by one. J.A. 83a-84a. When the process of adding the new articles/files is complete, the updated version of the compilation is separately designated, *e.g.* as NEXIS "Generation 101," and, in the terminology of NEXIS, is then "promoted" to the public in lieu of "Generation 100." *Id.*

As noted above, the individual articles/files that make up NEXIS each contain numerous electronic codes that are invisible to the NEXIS user. Some of the codes are added by the originating Periodical Publisher and the remainder by NEXIS. J.A. 82a. The codes enable the NEXIS operating software to identify the individual article/file from the others in the database according to any one of dozens of identifiers, including author, topic, keyword, date, words or phrases from the text of the article, or name of publication—or according to any *combination* of the various identifiers. J.A. 84a-85a.

The codes also enable the NEXIS software to execute "Boolean" searches of the database—searches using the connectors "and," "or," and "but not"—so that the NEXIS software can, in a single pass, compile from the mass of articles in the database, for example, all articles containing *either* the word "porpoises" *or* the word "dolphins" but *not* the phrase "Miami Dolphins." *See* J.A. 84a-85a.

A person can secure the NEXIS display—and/or printout or download—of the database articles by becoming a NEXIS subscriber, obtaining a password, and (with a few exceptions not pertinent here) by agreeing to pay a fee for use. J.A. 84a, 388a. When a subscriber enters her password and gains access to the database, she is presented, not with the text of any article, but rather with a menu asking her to identify a source, or a set of NEXIS files—denominated by NEXIS as either a "group file" or a "library," J.A. 85a—from which the subscriber would like to have NEXIS display, print out, or

download articles. *See* J.A. 84a-85a. Many of the NEXIS sources—including, for example the "Newsgroup File-All" source—encompass articles/files drawn from hundreds of newspapers, magazines, and other periodicals electronically linked together through NEXIS' internal codes. *See* J.A. 84a, 216a-328a, 330a.

As can readily be determined by accessing NEXIS, the subscriber, for example, can choose the "Newsgroup Files-All" source and, by entering a simple "author" or "byline" search, can cause the NEXIS software to pull up and display every article from every journal, magazine, and newspaper source within the NEXIS database by a particular author. If the search is for the articles authored by, *e.g.*, Stephen Jay Gould—and there are 98 such articles from 27 different publications—then NEXIS will display either (i) a numbered *list*, in reverse chronological order, of the titles of *all* of the 98 Gould articles, along with other identifying information including the word count of the article and the source periodical's name and date of issue; (ii) the *full text* of the 98 articles on that list in the same sequence (with the text of the first document appearing first and the text of the remaining documents accessible through a click of the "next document" button); or (iii) those portions of the articles that contain text within a certain number of words (usually 25) of the search term. *See* J.A. 85a-87a.

The NEXIS system not only provides computer displays of individual articles to subscribers, but also prints in hard copy form the full text of such articles and makes electronic copies of such articles—copies which can be downloaded to the subscriber's own electronic files for "off-line" use (*i.e.*, for use after the subscriber's telecommunication contact with NEXIS has been terminated). J.A. 90a. Thus, to return to the illustration, a NEXIS subscriber interested in a copy of the 98 Stephen Jay Gould articles in the "Newsgroup File-All" source can secure a NEXIS printout or download of the

complete text of those articles, and a NEXIS user interested in a copy of Gould's 1998-1999 articles can secure a NEXIS printout or download of that more limited compilation of articles.

Whether NEXIS provides an article by display, download, or printout, only the text of the article is provided, and not any of the pictorial, graphic, or layout elements of the article as it appeared in the print publication from which it originated. *See, e.g.*, L-II, pp. 89-91. And regardless of whether or not the article is an author-copyrighted contribution, the copyright notice that NEXIS appends to the article attributes copyright in the article to NEXIS and to the originating periodical, but *not* to the author of the article. J.A. 90a.

One of the almost infinite available combinations of articles that the NEXIS system can provide through a computer display, printout, or download is a compilation of all articles appearing in NEXIS drawn from a particular periodical issue—a compilation that can be assembled through the use of the "date" and "publication" identifiers. J.A. 88a. Given NEXIS' make up as a database of individual files/articles, the results of a search for articles from a particular day's edition will be displayed as a list or series of individual articles presented in an order that does not (except by sheerest coincidence) reflect the order in which the articles appeared in the original print issue. J.A. 502a-503a.

(ii) NEXIS operates under a series of licensing agreements in which the Periodical Publishers authorize not only reproduction and distribution of a particular periodical issue as a whole, but also reproduction and distribution of "any portion" thereof.

(a) The New York Times-LEXIS/NEXIS License

On January 31, 1983, the New York Times and LEXIS/NEXIS entered into a licensing agreement, which was in effect when all of the articles at issue in this case were first published in the Times. The agreement, in an attachment styled "Exhibit A," defines the term "Licensed Times Materials" to include "future sections and editions (including regional and national editions) of *The New York Times*, . . . excepting therefrom photographs, crossword puzzles, other graphic material and advertisements." J.A. 98a. The body of the licensing agreement then proceeds to grant to LEXIS/NEXIS "an exclusive worldwide copyright license" to "sell and display, publicly or privately," through "computerized electronic coded retrieval systems to which customers gain access through terminals," "all and *any portion of* the material set forth in Exhibit A (the 'Licensed Times Material')." Materials Lodged with Certiorari Petition, vol. 3, Exh. 38 at M3689 (emphasis added); J.A. 98a. The agreement further authorizes LEXIS/NEXIS to "sublicense" the rights LEXIS/NEXIS has obtained from the Times. *Id.* And, while the Times/LEXIS-NEXIS agreement grants LEXIS/NEXIS the right to sell and display all and "any portions of" the editions under license—including individual articles—the agreement explicitly *denies* LEXIS/NEXIS the "right to display or produce facsimile reproductions of The New York Times." J.A. 98a.

Each night, after the day's newspaper has been printed, the Times selects out of the day's edition the news and feature articles and, in line with the terms of the license provision permitting NEXIS to electronically publish "all and *any portions* of the [Times] materials," prepares a series of individual electronic files, each of which contains the text of one article. J.A. 73a. In so doing, the Times takes a number of steps to make the article/files searchable and displayable *as individual article/files*, including, *inter alia*, coding each file

according to such criteria as author, topic, keyword, etc. J.A. 75a-78a. "In the process, a substantial portion of what appears in that particular issue of the periodical is not made part of a file transmitted to [LEXIS/NEXIS] including among other things, formatting decisions, pictures, maps, tables, and obituaries." Pet. App. 4a.

The Times then transmits that series of article/files to NEXIS, J.A. 78a, and NEXIS, as we have seen, further codes each article/file and then adds the series of article/files to the NEXIS database. J.A. 81a, 83a-84a.[2]

(b) The Newsday-NEXIS License

Articles from Newsday first appeared in NEXIS in 1988 pursuant to an April 21, 1988 licensing agreement. That

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[2] A series of new individual files may be added to an electronic database in a particular sequence, but once the files are stored inside the computer drive housing the database, the computer's storage system will, with each use of the database, continuously reconfigure the arrangement of the files so that their storage arrangement no longer reflects their original sequence. The system performs these reconfigurations so as to ensure that the storage space continues to be utilized as efficiently as possible. As one scholar has put it:

> [A] computational system cares about how information flows within it, not about how the system takes up space. In computers a program or file may end up in different parts of the memory or disk when loaded onto two machines or onto one machine on different occasions, and it may be fragmented across far-flung regions of the disk or memory. As long as the information is preserved and the regions are properly linked, the program can work perfectly, even though we can never draw a circle around the part of the memory or disk that contains it. [S. Pinker, *Words and Rules* (Basic Books, 1999) 242.]

Thus, one cannot open up a computer and "draw a circle" around the group of files that contain, say, the text of articles constituting a particular issue of Sports Illustrated. While those files may share a "publication" and "date" code in common, those files are no more (and no less) closely linked to each other than files sharing the same "topic" and "author" code. *See also* Pet. Br. 43-44 n.30.

agreement, in its "Schedule A," defines the "Licensed Materials" as "all stories from Newsday" except for, *inter alia,* "Graphic materials," "Weather Forecast[s]," "Paid Death Notices," "Selected Wire Services," and "*Selected Syndicated Materials and Freelance Materials.*" J.A. 105a (emphasis added).[3] The licensing agreement begins by granting LEXIS/NEXIS "a non-exclusive world-wide license ... to use and *authorize use by others* of all or *any portion of* the information and materials identified in Schedule A hereto (the "Licensed Materials") in connection with [LEXIS/ NEXIS'] development, creation, rendition, *display, dissemination and distribution,* directly or through third parties, *of computer-assisted information products or services.*" [*Id.* (emphasis added)].

The license then goes on to particularize the rights included within the license:

> The rights embraced by the License include, but are not limited to, the right to display *and authorize displays of* Licensed Materials by means of computer-assisted devices, telecommunications and systems; the right to reproduce *and authorize reproduction of* Licensed Materials in visually perceptible or machine-readable copies in connection with computer-assisted information products or services. [J.A. 104a].

Thus, like the Times, Newsday authorized NEXIS to use all or "any portion" of the materials under license, with no

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[3] By excluding "selected" freelance materials, Newsday evidently was reserving the right to refrain from providing and licensing to NEXIS the use of individually copyrighted materials as to which Newsday was unable to secure assignments. Apparently because Newsday believed (erroneously it turned out) that it could validly secure copyright assignments from freelancers by means of legends stamped on the back of the checks issued to them, *see* note 1 *supra* and Pet. App. 3a n.1, Newsday did not select any of the Respondents' articles for exclusion from the materials licensed and transmitted to NEXIS.

restriction requiring articles from the same edition to be displayed or filed together as single units. And, just as the Times authorized LEXIS/NEXIS to grant sublicenses of Times materials, Newsday expressly authorized LEXIS/NEXIS to authorize NEXIS subscribers to reproduce and display all or any Newsday stories.

Pursuant to the license, Newsday each night transmits to LEXIS/NEXIS the licensed portions of a particular day's edition of the paper as a series of individual electronic files/articles, each of which is separately coded. J.A. 78a.

(c) The Time, Inc.-LEXIS/NEXIS License

On or about November 27, 1990, Time Inc. entered into a licensing agreement with LEXIS/NEXIS that was nearly identical to Newsday's. The "Licensed Materials" included all of the contents of the Time publications except, *inter alia*, "All material appearing on the cover page," "Graphic materials," and "Special issues of a publication (e.g. Sports Illustrated Year in Sports). . . ." J.A. 106a-107a. And, the license extended to LEXIS/NEXIS "the right to use and authorize use by others of all or *any portion*" of the materials, and "the right to reproduce and authorize reproduction of Licensed Materials in copies (including printed, electronically displayed, and machine-readable copies) in connection with computer-assisted information products or services." J.A. 107a (emphasis added).

Pursuant to the license, Sports Illustrated sends NEXIS a magnetic tape every week containing, in separate files, each article from the previous week's issue of the magazine. J.A. 78a.

(B) New *Y*ork Times OnDisc (NYTO)

(i) Respondent UMI's "The New York Times OnDisc," is a set of CD-ROMs, or computer-readable compact discs. The CD-ROM's store, in separate electronic files containing one

article per file, the text of New York Times articles from 1981 to the present—the very same "text-only" New York Times articles/files in NEXIS during that same period. J.A. 90a, 369a. Indeed, UMI receives the electronic text article/files that it encodes onto disc directly from *NEXIS*, and *not* from the New York Times. J.A. 102a, 90a.

As is the case with respect to the individual New York Times articles in NEXIS, each individual article in New York Times OnDisc is marked with codes, invisible to the user, that (i) enable the software operating the discs to cull the article from the mass of other articles, and (ii) electronically link one article to another. J.A. 91a.

(ii) The New York Times OnDisc is created and distributed pursuant to a three-way New York Times-LEXIS/NEXIS-UMI licensing agreement. J.A. 90a. The agreement distinguishes between "image" CD-ROM products, *i.e.*, products that display photographic or facsimile images of newspaper pages; and electronically coded "ASCII" CD-ROM products, *i.e.*, coded storage-and-retrieval products that display only the text of articles. J.A. 101a-103a. The agreement then assigns to UMI the "exclusive worldwide copyright license to manufacture and sell CD-ROM (ASCII) format versions of textual . . . materials" from the New York Times, and further provides that UMI is to obtain the individual articles that make up the contents of the CD-ROM's directly from LEXIS/NEXIS and not from the Times. J.A. 102a, 90a.

(C) General Periodicals On Disc (GPO)

(i) UMI's "General Periodicals OnDisc" is a set of CD-ROM's containing (i) articles from more than 200 publications or sections of publications from 1988 forward, J.A. 331a, 380a; and (ii) abstracts and indices of the articles designed to facilitate retrieval, display, and reproduction of

the individual articles by topic, author, and other criteria. J.A. 95a. Unlike NEXIS and The New York Times OnDisc, General Periodicals OnDisc displays facsimile images of the articles contained within it. J.A. 379a. Those images are created by a device that scans the original pages of the periodicals one by one and converts each page into an electronic computer-readable image. J.A. 380a. Like NEXIS, GPO identifies, displays, and prints individual *articles*, and not *issues* or *editions* of a periodical, in response to search requests. As UMI describes the product in its promotional literature:

> General Periodicals OnDisc (GPO) provides exact reproductions of *articles* in image format from approximately 200 of the most frequently used general-interest periodicals. . . . Users search the abstract-and-index database, locating and reviewing relevant citations and abstracts, then retrieve and print complete *article* copies from the image database—all with just a few keystrokes. [J.A. 331a (emphasis added).]

A user of General Periodicals OnDisc can thus retrieve a list of all articles on, say, the topic of "missile defense," and, by entering the citations generated by the list, cause the software operating the database to display or print out hard copies of all or any combination of the listed articles. Only the pages of the periodical issue containing the identified articles are displayed and/or printed, not the entire periodical issue. *See* L-II, pp. 144-145 (GPO printout of Respondent Mary Kay Blakely's 9/23/90 New York Times Magazine article which begins on page 26 and jumps to page 76).

The only New York Times materials available on General Periodicals OnDisc are the Book Review and Magazine *sections* of the New York Times Sunday edition; the

remaining sections of the Sunday edition are not available on GPO. J.A. 101a-102a.[4]

(ii) In 1989, the New York Times and UMI executed an agreement that permitted UMI to create a CD-ROM image product (later named General Periodicals OnDisc) that would include images of the Book Review and Magazine sections of the Sunday New York Times, along with materials from other periodicals, but not other sections of the New York Times. J.A. 101a-102a.

The licensing agreement provided that, although the contents of the Book Review and Magazine "will not be stored or made available as 'text' but as a facsimile of the entire page," articles could be searched and displayed as part of a page through the use of an electronic indexing system J.A. 101a-102a & n.28.

4. In the 1990-1993 period, each of the 21 articles authored by the six Respondents was published by one or the other of the Periodical Publishers. J.A. 68a-69a. After publication of the pertinent article, the Periodical Publisher provided the article to one or more of the Electronic Publishers, who in turn republished the article in electronic form. J.A. 90a.

B. Proceedings Below

On December 16, 1993, the Respondent authors filed suit in the U.S. District Court for the Southern District Court of New York alleging that the Periodical Publishers, by

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[4] The New York Times continuously registers copyrights in its daily and Sunday editions as the newspapers are published. At all times relevant here, the Times, in the registration forms submitted to the U.S. Copyright Office, treated the Book Review and Magazine sections of the Sunday Times as just that—sections of that day's newspaper—and *not* as independent publications. *See, e.g.*, L-II, p. 178.

licensing the republication of Respondents' copyrighted articles in the manner described above, and the Electronic Publishers, by republishing those articles in the manner described above, infringed the authors' copyrights in the articles. *See, e.g.*, J.A. 31a-32a ("[N]either Defendant New York Times nor Defendant [LEXIS/NEXIS] has ever obtained plaintiff['s] . . . consent to the inclusion of the article [authored by plaintiff] in an electronic database nor to the distribution, transmission and/or communication of an electronic copy to the public. . . . The conduct complained of . . . has violated and continues to violate . . . plaintiff's exclusive rights under the copyright [in the article] . . . in that it interferes with plaintiff's exclusive right to reproduce or license reproduction of the copyrighted work, to distribute or license distribution of copies of the copyrighted work, to publicly . . . display the copyrighted work . . . and to authorize all of the same.")

At the conclusion of discovery, the parties filed cross motions for summary judgment. The Respondent authors argued that the Petitioner publishers' reproduction and distribution of the authors' copyrighted contributed articles was outside the bounds of the three delimited privileges accorded by § 201(c) of the Copyright Act and therefore constituted infringement of the authors' copyrights. The Petitioners, for their part, asserted that § 201(c) privileges these reproductions and distributions of the authors' contributions.

The District Court granted summary judgment in favor of the Petitioner publishers on the theory that NEXIS and the other electronic databases were "revisions" of each and every periodical issue contained within the databases, and that inclusion of the authors' articles in the databases was within the § 201(c) privilege for reproducing and distributing an author's contribution to a periodical issue in a "revision of that [periodical issue]." Pet. App. 76a.

The Second Circuit reversed in a unanimous opinion by Judge Winter. The Second Circuit held that, because "NEXIS is a database comprising thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals," "[i]t can hardly be deemed a 'revision' of each edition of every periodical that it contains." Pet. App. 14a. The other two electronic databases likewise "c[ould] not be said to be a 'revision' of any (or all) particular editions" contained therein, but instead were "new antholog[ies]." Pet. App. 17a. And, because the databases were not revisions of the pertinent periodical issues, the court of appeals reasoned, the publishers exceeded the § 201(c) privilege and infringed the authors' copyrights. *Id.*

SUMMARY OF ARGUMENT

1. Section 201(c) of the Copyright Act confirms that, in the absence of an express agreement to the contrary, an author who contributes an article to a "periodical issue"—or to any other "collective work" as defined in § 101 of the Act—retains ownership of the copyright in the contributed article.

Section 201(c) also grants the periodical publisher—as the "collective work" copyright owner of the periodical issue—the delimited privileges to reproduce and distribute the author's contribution as part of (i) "that particular" periodical issue, (ii) "any revision of that" periodical issue; and (iii) "any later [periodical issue] in the same series."

The Petitioner publishers invoke the second of § 201(c)'s three stated privileges, and claim that they are reproducing and distributing to the public electronic copies of their periodical issues and that this activity is within their § 201(c) privilege to publish "any revision" of these periodical issues.

It is the Respondent authors' position that what Petitioners are doing is making electronic reproductions and distributions

of the authors' copyrighted contributed articles (i) as freestanding works, and (ii) in compilations of articles that are entirely different "collective works" from the periodical issue in which the article originally appeared, and that each of these electronic publishing activities is well outside the § 201(c) privilege.

2. Section 201(c) recognizes two distinct copyrights: the author's copyright in her contribution to a periodical issue, and the publisher's copyright in the periodical as a collective work. The § 201(c) privileges prevent any resulting impasse between these copyright owners by permitting the publisher to reproduce and distribute the periodical issue without any express copyright grant from the authors of the contributed articles. This privilege thus facilitates the publication of periodicals and other collective works in a manner that does not disturb the author's copyright in her contributed article.

The second § 201(c) privilege—which permits a periodical publisher to reproduce and distribute an author's copyrighted article in "any revision of" the periodical issue in which the article originally appeared—is at the center of this case.

Given the standard meaning of "revision," the Copyright Act's definition of "collective work," and the Act's characterization of the collective work copyright, a second collective work is a revision of the first collective work when the second work is of the same type as the first and when the second work is an amended version of the first comprised of contributions of the same kind as were included in the first that are assembled into a collective whole according to the same informing "selection, coordination, or arrangement" principles that characterized the first work.

In light of that understanding, and of § 201(c)'s recognition of the author's copyright in her contributed work, the privilege does *not* extend to a periodical publisher's reproduction and distribution of an author's copyrighted

contributed article as a *freestanding work.* Nor does the privilege extend to a periodical publisher's reproduction and distribution of a contributed article in a compilation of articles that is entirely different as a collective work from the periodical issue in which the article originally appeared.

3. The pertinent Petitioner electronic reproductions and distributions at issue here are typified by those effected by LEXIS/NEXIS. On proper analysis, those reproductions and distributions are of the following kinds:

(i) the NEXIS-provided computer display, printout, or download of a copy of a particular author-copyrighted article to a NEXIS subscriber;

(ii) the NEXIS computer display, printout, or download to a subscriber of a compilation of articles that includes the copyrighted article together with other articles by the same author, or on the same subject, or with the same keyword, or the like; and

(iii) NEXIS' "promot[ion] to the public"—NEXIS' term for "publishing"—a new version, or "generation," of the NEXIS compilation of articles in lieu of the prior generations of the compilation.

And, on the proper understanding of the scope of the § 201(c) "any revision of that collective work" privilege, all three classes of NEXIS reproductions and distributions fall well outside that privilege. None of the Petitioners' efforts to recast NEXIS' electronic publishing activities to make those activities fit within the § 201(c) privilege are availing. And, because for all purposes relevant to the § 201(c) analysis, Petitioner UMI's electronic publishing activities are functionally equivalent to NEXIS, Petitioners' efforts to recast UMI's activities to make them fit within the privilege likewise are unavailing.

ARGUMENT

The 1976 Copyright Act's basic ownership rule is that copyright in an "original work[] of authorship" "vests initially in its author." 17 U.S.C. §§ 102, 201(a). Copyright gives the author a set of exclusive rights in the work, including the rights "to reproduce the work in copies" and "to distribute copies of . . . the . . . work . . . to the public by sale." *Id.* § 106.

Section 201(c) of the Act confirms that, in the absence of an express agreement to the contrary, an author who contributes an article to a "periodical issue"—or to any other "collective work" as defined in § 101 of the Act—retains ownership of the copyright in the contributed article.

Section 201(c) also grants the periodical publisher—as the "collective work" copyright owner of the periodical issue—the delimited privileges to reproduce and distribute the author's contribution as part of (i) "that particular" periodical issue, (ii) "any revision of that" periodical issue; and (iii) "any later [periodical issue] in the same series."

The § 201(c) privileges are incidental to, and coextensive with, the publisher's right, as a collective work copyright owner, to reproduce and distribute the periodical, and serve to facilitate the exercise of that right. While the periodical publisher can exploit the contributed article through these privileges, the publisher has no copyright at all in the contributed article as such. The author of the article remains the owner of the copyright in the article with the exclusive rights, among others, to reproduce and distribute the article as a freestanding work or through a different periodical issue or other collective work.

In this copyright infringement case, the Respondent freelance authors complain that the Petitioner Periodical Publishers, acting through their licensees, the Petitioner

Electronic Publishers, have improperly "reproduced . . . and distributed copies of the [authors'] work[s] to the public by sale."

The Petitioners respond by invoking the second of § 201(c)'s three stated privileges, and by claiming that their challenged "electronic[] publishing" activity consists of reproducing and distributing to the public "electronic copies" of their periodical issues and that this activity is within their § 201(c) privilege to publish "any revision" of these periodical issues. Petitioners' Brief ("Pet. Br.") i, 2, 41; *id.* at 39-46.

The direct, dispositive answer to the Petitioners' reliance on the second § 201(c) privilege is that the Petitioners' electronic publishing activity at issue here is leagues away from the electronic reproduction and distribution of "revisions" of the periodical issues in which the Respondent authors' copyrighted articles originally appeared. What Petitioners are doing is making electronic reproductions and distributions of the authors' articles (i) as freestanding works, and (ii) in compilations of articles that are entirely different "collective works" from the periodical issue in which the article originally appeared. Each of these electronic publishing activities is well outside the § 201(c) privilege.

It is fair enough for the Petitioners to denominate their endeavors as "electronic[] publishing," and, for the present purposes, to insist that such publishing is to be judged on a Copyright Act "media neutrality" basis.[5] The Petitioners are

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[5] We pause to elaborate on our reasons for accepting only in carefully guarded terms ("for the present purposes") Petitioners' media neutral approach.

There is the most substantial question as to whether the § 201(c) privileges permit collective work copyright owners to *publicly display* an author's copyrighted contributed work, *e.g.*, through a computer display of the article. *Cf.* 17 U.S.C. § 106. The Register of Copyrights in a

however quite wrong in suggesting that there is some dispute between the parties here regarding media neutrality. There is not.

Our legal position is concerned *exclusively* with the Petitioners' reproduction and distribution of the Respondents' copyrighted contributed articles as freestanding works and in compilations of articles that are different collective works from the periodical issue in which the Respondents' articles originally appeared. Our legal position is *not* concerned at all

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response, printed in the Congressional Record, to a request by Congressman James P. McGovern for an analysis of the Copyright Act issues implicated by this litigation, states that the answer is "no":

> Section 106 of the Copyright Act, which enumerates the exclusive rights of copyright owners, includes an exclusive right to display their work publicly. Among the other exclusive rights are the rights of reproduction and distribution. The limited privilege in § 201(c) does not authorize publishers to display authors' contributions publicly, either in their original collective works or in any subsequent permitted version. It refers only to "the privilege of reproducing and distributing the contribution." [147 Cong. Rec. E 182-E 183 (Feb. 14, 2001 daily ed.).]

And, the Register then outlines the basis for her position at length and in so doing opines that in the § 201(c) context the "focus on the media neutrality of the Act is misplaced." *See id.* at E 183.

Respondents argued this point in the District Court, but that court concluded that the "public display" of a contributed work is a type of reproduction and distribution of the work, and that the § 201(c) "reproduction and distribution" privileges authorize such displays. Pet App. 53a-54a. And, the Respondent did not press the point in the Second Circuit. Nor did the Court of Appeals advert to the point in its decision.

Against that background we take it as a given in this Court that there is a § 201(c) display privilege subsumed within the § 201(c) reproduction and distribution privileges, and that, in these circumstances, it is proper to treat with § 201(c) as a "media neutral" provision. We argue the § 201(c) issue decided below and presented here on that basis.

with the circumstance that the Petitioners are making reproductions and distributions through electronic publishing rather than print publishing.

This copyright case is no different from a case precipitated by a *print republishing* endeavor in which periodical publishers license print republishers and provide the republishers with reformatted press plates of periodical issue articles on an article-by-article, issue-by-issue basis; the republishers code and store the plates; and, on subscriber orders, the republishers print in pamphlet form and deliver any individual article, or a variety of compilations of articles—*e.g.* "author" compilations or "subject" compilations—drawn from multiple periodicals.

In such a case, the authors of the contributed copyrighted articles would have the same infringement claim as the authors have here, and the periodical publishers and print republishers, for better or worse, would have the same § 201(c) privilege response as the Petitioners have here, and only that response. In both instances, as we will show, that response fails.

With these somewhat lengthy preliminaries, we turn first to the proper interpretation of § 201(c), reading its words according to their ordinary and accepted meaning in the context of the Copyright Act as a whole, and taking into account the evolution of the statutory text and the legislative explanations of the provision's purposes and effect. *Infra* at pp. 22-32. With the governing legal principles firmly in mind, we then address and rebut the Petitioners' claim that the reproductions and distributions here are of revisions of the periodical issues in which the Respondent authors' copyrighted articles originally appeared. *Infra* at pp. 32-50.

A. Section 201(c)'s Statutory Language

Section 201(c) provides:

> (c) Contributions to Collective Works.—Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

1. Section 201(c)'s first sentence confirms the Copyright Act's basic ownership rule—"[c]opyright in a work . . . vests initially in the author," § 201(a)—for one particular class of works: "separate contribution[s] to a collective work." Where a work is written for contribution to a "periodical issue, anthology or encyclopedia," or other "collective work," and is not a "work made for hire," the copyright in the contributed work vests in the author of that work. And, as stated in § 106 of the Act, it is the author, by reason of her copyright in the contribution, who has "the exclusive rights," *inter alia*, "to reproduce the copyrighted work in copies," "to distribute copies ... of the copyrighted work to the public by sale . . . ," and "to authorize" others to make such reproductions and distributions.

2. Section 201(c)'s second sentence addresses the legal consequences that attach when an article is contributed to a collective work such as a periodical issue. Understanding its logic requires an understanding of the Copyright Act defined terms on which it rests.

A person who "assemble[s]" separate and independent contributions into a "collective whole," *e.g.*, a periodical issue, creates a "compilation," which itself is an "original work of authorship." 17 U.S.C. § 101. And, the term "'compilation' includes 'collective works,'" *viz.* "a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." *Id.*

The person who assembles the periodical issue—the periodical publisher—is entitled to "[c]opyright protection" for that work. 17 U.S.C. § 103(b). That copyright protection extends "only to the material contributed by [the person who assembles the periodical issue], as distinguished from the preexisting material [the individual articles] employed in the [periodical issue]." *Id.*

In other words, the publisher's copyright protection runs to the publisher's "collection and assembling of [contributed articles] . . . selected, coordinated or arranged in such a way that the resulting [periodical issue] as a whole constitutes an original work," 17 U.S.C., § 103, but *not* to the author's copyrighted contributed articles included in the periodical. The author's copyright in her article, recognized in § 201(a) and again in the first sentence of § 201(c), is thus distinct from the publisher's copyright in the periodical issue as a collective work.

At the same time, the accepted and expected means for the publisher to exploit the collective work copyright in the periodical issue is for the publisher to reproduce and distribute the periodical to the public—in real world terms, to reproduce and distribute not the publisher's "selection, arrangement or coordination" of articles in the abstract, but those elements of assembly articulated through the collection of individual contributions assembled into a collective whole.

Without some meliorating privileges, the foregoing copyright rules could produce an impasse in cases where the author owns the copyright in the contributed article and has not expressly granted reproduction and distribution rights to the periodical publisher. *Cf. Stewart v. Abend*, 495 U.S. 207 (1990) (copyright owner of derivative work is precluded from exploiting the copyright in the derivative work after the initial grant of rights from the owner of the copyright in the pre-existing material from which the derivative work was drawn lapsed and the successor-in-interest to the preexisting-materials copyright owner refused to make a new transfer).

The first question that arises from the coexistence of—and tension between—contributed work copyrights and collective work copyright is whether, in the absence of an express transfer from each contributing author, the publisher of a periodical issue will be privileged to make any publication of a periodical issue that includes the contributed articles.

And, it is § 201(c)'s second sentence—providing that "the owner of copyright in the collective work is presumed to have acquired ... the privilege of reproducing and distributing the contribution as part of that particular collective work"—that resolves this question. It does so by permitting the publisher to reproduce and distribute the periodical issue without any express copyright grant from the authors of the contributed articles. This privilege thus facilitates the publication of periodicals and other collective works in a manner that does not disturb the author's copyright in her contributed article.

A second question is whether the periodical publisher, as a collective work copyright owner, can exploit the contributed article in collective works other than the original periodical issue. Section 201(c)'s second sentence resolves this question in measured terms by providing the publisher "the privilege of reproducing and distributing the contribution as part of . . . any revision of that collective work," *viz.*, any

revision of the particular periodical issue in which the contributed article originally appeared, and the "privilege of reproducing and distributing the contribution as part of . . . any later collective work in the same series."

a. The first of these two privileges—to reproduce and distribute an author's copyrighted article in "any revision of that collective work"—has been the center of this case.

The Copyright Act does not define "revision." Nor is that term a copyright term of art. And, none of the secondary legislative materials provide a precise meaning of "revision" as used in § 201(c).

The definitions of "revision" as the term is used in its ordinary sense are, moreover, less than exact. A revision is "something made by revising" and to revise is "to look at or go over again for the purpose of correcting or improving" or "to make a new, amended, improved or up to date version of." *Webster's Third New Int'l Dict.*, 1944 (1968). Thus a revision is the product of a certain kind of endeavor—returning to an original for the purpose of correcting, improving, etc. the original—that produces a certain result—an amended version of the original, and not something that is no longer a recognizable version of the original. On any understanding of the term, differences can exist between any two works so that the second is not judged to be a revision of the first, but a separate work in itself. And, on any understanding, that judgment turns on determining the first work's defining characteristics.

But, the context provided by § 201(c) does give a significant measure of additional content to "revision" in its ordinary sense. The § 201(c) privilege allows a collective work copyright owner to include a contributed work *only* in "any revision of *that collective work*"—*viz.*, only in a revision of the original collective work that included the contributed

work. There is no § 201(c) privilege to include the contribution in "any revision of any work."

The Copyright Act, moreover, *does* define "collective work"—"a work such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101. Further, the Act *does* provide that the copyright owned by the assembler of a collective work is in the "material contributed by the author [*i.e.*, the assembler] of such work," *viz.*, in the assembler's "select[ion], coordinat[ion], and arrange[ment]" of the "preexisting materials" employed in the work, "as distinguished from the preexisting material" itself. *Id.* §§ 101, 103(b).

What follows from the standard meaning of "revision," the Act's definition of "collective work," and its characterization of the collective work copyright is this: a second collective work is a revision of the first collective work when the second work is of the same type as the first—a daily newspaper issue, a general encyclopedia, etc.—and when the second work is an amended version of the first, comprised of contributions of the same kind as were included in the first that are assembled into a collective whole according to the same informing "selection, coordination, or arrangement" principles that characterized the first work.

This explication of the phrase "any revision of that collective work" does not, to be sure, provide a litmus test for resolving borderline cases. But it does have sufficient explanatory power to resolve two highly pertinent non-borderline cases:

- The privilege does *not* extend to a periodical publisher's reproduction and distribution of an author's copyrighted contributed article as a *freestanding work*. The article as such is not a collective work at all much less a revision of the

original periodical issue. And, the author of the contributed article—not the publisher—is the copyright owner of the article. Indeed, § 201(c)'s most basic point is to confirm that the author of the contributed article is its copyright owner—and that the publisher has no copyright in the article as such.

- The privilege does *not* extend to a periodical publisher's reproduction and distribution of a contributed article in a compilation of articles that is entirely different as a collective work from the periodical issue in which the article originally appeared: *viz.*, in a compilation that collects and assembles a far different set of contributed works according to far different "selection, coordination and arrangement" criteria. Such a compilation is *not* on any view a "new, amended, improved, or up to date version" of the particular periodical issue in which the contribution originally appeared.

These cases are pertinent because the Petitioners have effected just these kinds of reproductions and distributions of the Respondent authors' copyrighted articles. *Infra* at 32-50.

b. The last § 201(c) privilege, which Petitioners have not invoked here, permits the republication of a contributed work in the course of publishing "any later collective work in the same series." This provision says—and throughout this litigation has been taken by the parties to say—no more and no less than that the publisher of a periodical (or other publication that appears in intervals over time) who has included an article in an earlier issue in a continuing series of similar periodical issues can include the article in a later issue in the series. There one day may be a dispute over whether two periodical issues are "in the same series," but no such dispute is involved in this case.

This privilege does, however, throw a cross light on the two preceding § 201(c) privileges. Like the modifier "only" that applies to all the stated privileges, the inclusion of the last privilege makes it manifest that § 201(c) provides

periodical publishers three expressly stated privileges *and no others*. And, the terms of the final two privileges taken together reinforce the conclusion that § 201(c) only permits a publisher to include a contribution to a particular periodical issue in a second periodical issue that is closely related to the original periodical—*viz.*, in an amended version of the original or in a later issue that is in a succession of similar periodical issues.

B. The § 201(c) Legislative Materials

The background § 201(c) legislative materials confirm that the foregoing reading of the provision's language in its Copyright Act context is the correct reading.

1. The 1976 Copyright Act was the culmination of a Congressional undertaking that began in 1955 with a charge to the United States Copyright Office to prepare the way for a revision bill. *See* House Report 94-1476, 94th Cong. 2nd. Sess., pp. 47-48 (1976) ("House Report" 94-1476).

In carrying out that charge, the Copyright Office—after a period of study and debate that included the copyright law constituencies—developed a 1961 set of recommendations for a copyright law revision bill and drafted a 1963 revision bill, a 1964 bill, and a 1965 bill. Both the 1964 bill and the 1965 bill were introduced in Congress. And the 1965 bill, which was accompanied by an extensive explanatory report by the Register of Copyrights, became the base for the legislative effort that led to the 1976 Act. *See* House Report 94-1476, pp. 47-48 (outlining these developments).

All four of the Copyright Office proposals addressed the contributed works/collective works issue as a discrete issue. In so doing each proposal treated somewhat differently with a periodical publisher's reproduction and distribution of a contribution to a particular periodical issue in a second collective work.

• The 1961 recommendation accorded the publisher the "right to publish it [the contributed work] in a *similar composite work.*" Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong. 1st Sess. (H. Judiciary Comm. Print 1961).

• The 1963 bill provided the publisher "only the privilege of publishing the contribution in *that particular collective work.*" S. 3008, 88th Cong. 2nd Sess., § 14(c) (1964); H.R. 11947, 88th Cong. 2nd Sess., § 14(c) (1964).

• The 1964 bill provided the publisher "only the privilege of reproducing and distributing the contribution as part of that [the original] collective work and *any revisions of it.*" Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 2nd Sess., p. 15 (H. Judiciary Comm. Print (1964).

• And, the 1965 bill, like the present law, accorded the publisher "only the privilege of reproducing and distributing the contribution as part of that particular collective work, *any revision of that collective work and any later collective work in the same series.*" S. 1006, 89th Cong. 1st Sess., § 201(c) (1965), H. R. 4347, 89th Cong. 1st Sess. § 201(c) (1965).

It is telling that none of these proposals can fairly be read to accord a periodical publisher any privilege to reproduce and distribute a contributed article as a freestanding work and that not even the broadest of the four—the 1961 recommendation proposal—can be read to provide any privilege to include the contributed article in a compilation of articles that is entirely different as a collective work from the periodical issue in which the article originally appeared.

It is telling, too, that the Copyright Office did not in the end recommend to Congress the 1961 formulation most favorable to the publishers, or the 1963 formulation most

favorable to the authors, or the somewhat ambiguous 1964 formulation, but rather the more nuanced 1965 formulation.

It is evident then that the Copyright Office, after considering its earlier proposals and the competing arguments, concluded that the 1965 bill struck the best balance between facilitating the publication of collective works and providing authors the opportunity to exploit their copyright in their contributed works. And, Congress, in acting on the Copyright Office's proposal, and after considering the arguments of the publishers and the authors, came to the same conclusion. It follows that the § 201(c) privileges are to be read as three carefully considered, discrete and delimited privileges and not as some broad or general privilege—*viz.*, read as the statutory text is written and according to its terms.

2. House Report 94-1476—the Committee Report that was last in time and that accompanied the bill that formed the backbone of the Conference Report and the final legislation—illuminates the § 201(c)(1) text in a number of ways. In so doing, it draws heavily on the Register of Copyright's earlier reports and their explication of the provision.

• The House Report begins by stating that § 201(c)(1)'s first sentence establishes the new contributed works/collective work regime's "*basic principle*"—"that copyright in the individual contribution and copyright in the collective work as a whole are separate and distinct, and that the author of the contribution is, as in every other case, the first owner of copyright in it." House Report 94-1467, p. 122.

That principle is "basic" in two respects. In large part, the prior law had been unsatisfactory in failing to draw a clear line between a contributing author's copyright and the collective work owner's copyright. Section 201(c) draws such a line. And, in so doing § 201(c) makes it plain that the

author has the copyright in the "individual contribution," that the collective work copyright owner has the copyright in that work—and that the latter has no copyright in the contribution as such. By allocating these copyrights in this way § 201(c) provides the author the exclusive right to reproduce and distribute the contributed work as a separate work or in a collective work different from the collective work in which the contribution originally appeared.

• The Report makes it plain that § 201(c)(1) "does nothing to change the rights of the owner of copyright in a collective work under the present law" but *is* intended "to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions." House Report 94-1476, p.122. As to "rights in contributions," then, the Act, and not the pre-Act understandings, controls.

• The Report emphasizes that Congress' primary interest in changing the prior law was to "preserv[e] the author's copyright in a contribution even if the contribution does not bear a separate notice in the author's name, and without requiring any unqualified transfer of rights to the owner of the collective work." House Report 94-1476, p.122. This echoes the opening of the Report explaining that § 201(c)'s "basic principle" is to provide the author of a contributed work the copyright in that work and the attended rights to reproduce and distribute that work as a separate work or in a collective work different from the collective work in which the contribution originally appeared.

• The Report concludes by amplifying on the § 201(c) collective works copyright owner's privileges stated therein. The Report separates out the first—the privilege to reproduce and distribute the contribution as part of that collective work—as the "basic" § 201(c) privilege and as one that is "fully consistent with present law and practice, and represents a fair balancing of equities." House Report 94-1476, p.122.

In its final passage—and the one most directly pertinent here—the Report focuses on the two remaining § 201(c) privileges. The Report emphasizes that these privileges provide for "*republishing the contribution under certain limited circumstances.*" To illustrate what those circumstances are, the Report states two proper exercises of these privileges: "a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it." In contrast, "the publisher could *not* revise the contribution itself *or include it in a new anthology or an entirely different magazine or other collective work.*" House Report, 94-1476, pp. 122-23 (emphasis added).

The Report thus provides the strongest confirmation of the conclusion that § 201(c)'s statutory language does not accord a periodical publisher any privilege to republish a contribution to a periodical issue in a compilation of articles that is entirely different as a collective work from the original periodical—*viz.* in a compilation that constitutes a "new anthology or an entirely different magazine or other collective work."

C. The Petitioners' Electronic Publishing Activities Exceed the Scope of the § 201(c) Privilege

On analysis, the Petitioners' position in this case comes down to this: (i) the set of articles that a Periodical Publisher pulls from a given issue of its periodical and converts into electronic form for transmission to the Electronic Publishers constitutes a § 201(c) "revision" of that periodical issue, Pet. Br. 40; and (ii) the Electronic Publishers' "reproduct[ions]" and "distribut[ions] ... to the public by sale" at issue in this case are of these sets of electronic periodical issue articles. Pet. Br. at 47 (contending that this case turns on "the content of those allegedly directly infringing copies, *as they were created and fixed on an issue-by-issue basis*") (emphasis added).

The Petitioners' first point is nothing but a distraction. Section 201(c) is not solely, or even primarily, concerned with the transmission of text materials by one publisher to a second publisher antecedent to the latter's reproduction and distribution to the public of those text materials. The provision is instead very much concerned with what the second publisher then reproduces and distributes to the public—in this case, what the Electronic Publishers, as the Periodical Publishers' licensees, reproduce and distribute to the public. Thus, the critical question here is whether, as the Petitioners imply, the Electronic Publishers confine themselves to reproducing and distributing to the public author-copyrighted articles from a particular periodical issue as part of the *set* of articles from that issue that Petitioners identify as the "revision" of the issue.

The answer to that question is that the Electronic Publishers' reproductions and distributions are *not* so confined. The transmissions of sets of articles from a particular periodical issue on which Petitioners focus—the transmissions from the Periodical Publishers to the Electronic Publishers—are but a transitory, intermediate production step in the process of reproducing the Respondent authors' copyrighted articles on an individual article basis and of distributing copies of those articles to the public on an individual article basis. The pertinent LEXIS/NEXIS "distribut[ions] of copies . . . *to the public* by sale" are:

(i) the NEXIS-provided computer display, printout, or download of a copy of a particular author-copyrighted article to a NEXIS subscriber;

(ii) the NEXIS computer display, printout, or download to a subscriber of a compilation of articles that includes the copyrighted article together with other articles by the same author, or on the same subject, or with the same keyword, or the like; and

(iii) NEXIS' "promot[ion] to the public"—NEXIS' term for "publishing"—a new version, or "generation," of the NEXIS compilation of articles in lieu of the prior generations of the compilation. *See supra* at 3-4 (explaining in detail what LEXIS/NEXIS does when it "promotes" an updated generation of NEXIS to the public).

As we proceed to show, not only are these "reproduc[tions] and distribut[ions]" of something other than the sets of electronic periodical issue articles formed by the Periodical Publishers on an issue-by-issue basis, all three are reproductions and distributions that fall well outside the § 201(c) privilege.

1. Very simply stated, in every respect and for all of its purposes, the NEXIS system is a system of individual article/files. From the point at which licensed text materials are received by NEXIS from its various periodical-publisher licensors to the point at which NEXIS provides computer displays, printouts, and downloads of licensed materials to its subscribers, the unit of text material that is being stored, coded, identified, displayed, printed out, downloaded, and otherwise processed, reproduced or distributed is the unit consisting of the individual article/file.

When, for example, a newspaper publisher transmits text materials from a day's newspaper to NEXIS, the Electronic Publisher assigns each *article* in the newspaper—not each *section* of the paper and not the *entire edition* of the paper—to a separate article/file and gives that file its own identifier. And, when text materials are further electronically coded so that they can be linked to other materials in the database, it is each individual article/file—and not any other unit of text material—that is coded.

The very point of proceeding in this way is to enable NEXIS (i) to cull any individual article/file from the mass of articles/files in the data bank and to provide a computer

display, printout, or download of that individual article as an individual article and without providing the collective work in which the article first appeared; and (ii) to make compilations of articles selected, coordinated and arranged according to an author criterion, a subject criterion, or others coded into the searching/linking software.

That being so, it is plain that when NEXIS—in response to a subscriber request for a particular author-copyrighted article —provides a computer display, printout, or download of that article to the subscriber as a freestanding article, the NEXIS reproduction and distribution of that article is not within any § 201(c) privilege.

2. The Petitioners offer three alternative views of the NEXIS reproduction and distribution of author-copyrighted contributed articles as freestanding works. Each one distorts the realities more than the last.

a. The Petitioners first argue that each author-contributed article NEXIS provides through a computer display, printout, or download is taken from a potential "revision" of the original periodical issue—consisting of the set of article/files drawn from that issue and coded by date and publication—stored in the database. Pet. Br. 42-43. NEXIS' reproduction and distribution of an individual article drawn from that periodical issue, say the Petitioners, should on that account be treated as a reproduction and distribution not of an individual article but of the revised original periodical issue as a whole. *Id.*

The Petitioners' suggestion is artificial in the extreme. Each individual article in the NEXIS system is in a self-contained file with its own separate identifier, and that file is the only file activated by a subscriber request for the article that the file contains.

Furthermore, the article/files in a computer data system are constantly shifting place as the system is used and do not

remain in any fixed serial order—as Petitioners themselves acknowledge. *See* Pet. Br. 43-44; *see also supra* at 8 note 2.

Equally to the point, no NEXIS article/file is included in only one "potential" compilation of articles. Given the nature of the finding/labeling codes embedded in each article/file, each article is simultaneously linked to a potential "author" compilation, a potential "subject" compilation, a potential "keyword" compilation and so forth. *Supra* at 4. And, the Petitioners offer no justification—because there is none—for treating the potential date-and-publication compilation as the compilation of reference.

Beyond that, when NEXIS reproduces and distributes a particular author-copyrighted article, the existence in the NEXIS database of a number of *other* article/files that, if assembled, might constitute a revision of the periodical issue in which the article originally appeared, does nothing to change the fact that the contributed article is being "reproduc[ed] . . . and distribut[ed] [as] an individual contribution apart from the remainder of the publication." And that being so, a NEXIS-provided display, printout, or download of the article as an individual article constitutes an infringement even on the Petitioners' own reading of § 201(c). *See* Pet. Br. 39 ("Section 201(c) prevents a publisher from reproducing, revising, or distributing an individual contribution apart from the remainder of the publication.")

Petitioners are thus left to argue that because "Respondents' contributions are tagged with information —such as the author's identity, the name of the periodical, and the page number and column in which it appears," each contribution—even when separately displayed, printed out, or downloaded—is still part of the original periodical issue. Pet. Br. 42-43. This is sheer casuistry. The "tag[ging]" is necessary only because the article is *no longer part of the*

original periodical issue. Tagging something does not make it part of another thing. And, it would make nonsense of § 201(c) and of the author's ownership of the copyright in her contributed article, to conclude that a periodical publisher could publish a contribution as a freestanding work so long as the publisher added a note or legend to the reprint identifying the publication in which and the page number where the contribution first appeared. Section 201(c) is not a trademark provision concerned with fair and proper identification of source; it is a copyright provision concerned with the copyright owner's right to reproduce and distribute her work.

Given the foregoing—and given the novelties of electronic publishing—we believe it is helpful to consider a print analog. Suppose, for example, that the New Yorker magazine put out a fiction issue containing four separate novellas by freelance authors and thereafter put out a separately bound reprint of each work and offered each reprint volume to the public for sale as a freestanding work. It is too clear for doubt that these reprints are not within any § 201(c) privilege and constitute an infringement of each of the four authors' individual copyrights in their respective contributed works. And, all of this would be so even if the New Yorker continued also to reproduce and distribute the fiction issue in which the four novellas appeared together.

b. Petitioners argue too that if there is any infringing reproduction and distribution of the Respondent authors' contributed articles here, it is the individual NEXIS *subscriber* that is the sole infringer. Pet. Br. 45. Petitioners thereby attempt to fit this case within *Sony Corporation of America v. Universal Studios, Inc.*, 464 U.S. 417 (1984). *Sony* holds that a manufacturer of a machine that can be used to copy copyrighted material—there, a videotape recorder (VTR)—is not liable for contributory infringement, where the machine has substantial non-infringing uses and where the defendant itself has neither engaged in the copying of

copyrighted materials nor authorized such copying. *Id.* at 456.

NEXIS, Petitioners would have it, is like the machine in *Sony*, since one use to which NEXIS can be put is to provide the computer display, printout, and download of all NEXIS-available articles from a particular periodical issue—of a compilation that Petitioners style a "revision" of that periodical issue. But NEXIS does not distribute machines that can make copies of text materials in the database. *NEXIS itself reproduces and distributes those text materials.* Indeed NEXIS has negotiated and paid for licenses from periodical publishers to do just that. And, the *Sony* Court made it clear that its ruling there provides no defense to a party that does in fact make infringing reproductions and distributions of an author's copyrighted work. *Id.* at 436.

The *Sony* Court did so by reaffirming *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911), where the defendant motion picture producer was itself a distributor of the infringing work and had been held liable for infringement on that basis. *Kalem* was distinguishable from *Sony*, because "the producer in *Kalem* did not merely provide the 'means' to accomplish an infringing activity; the producer supplied the work itself, albeit in a new medium of expression. Sony in the instant case does not supply Betamax consumers with [the copyright owner] respondents' works; respondents do." 464 U.S. at 436.

Here NEXIS is most certainly "supply[ing] the [authors' copyrighted] work[s] [them]selves" in providing computer displays, printouts, and downloads of the authors' copyrighted articles in full text.

The *Sony* Court's reasoning, moreover, makes it clear that the *Periodical Publishers'* actions here constitute infringement as well. For *Sony* confirms the proposition—made plain in the text of the Copyright Act itself, *see* 17 U.S.C. § 106—

that an author's exclusive rights include not only the "exclusive right[]" to reproduce and distribute copies of a copyrighted work, but the exclusive right "*to authorize* [others]" to do the same, whether through licensing or otherwise. Thus, the *Sony* Court, citing § 106, confirmed that "an infringer is not merely one who uses a work without authorization by the copyright owner, but also one who *authorizes* the use of a copyrighted work without actual authority from the copyright owner." 464 U.S. at 435 n.17.

In this case, each of the Periodical Publishers licensed LEXIS/NEXIS to reproduce and distribute to the latter's subscribers "all *and any portions*" of the "Licensed Materials." *Supra* at 7-10. Thus, the licenses on their face authorize NEXIS, *inter alia*, to provide computer displays, printouts, and downloads to its subscribers of *discrete, individual articles* from the newspapers and periodicals at issue. An individual article certainly constitutes "any portion" of the Licensed Materials. Petitioners would be hard-pressed to contend otherwise, having championed in another context the proposition that "'any' is a term of considerable breadth," Pet. Br. 15, which "does not permit . . . artificially imposed" limits, *id.* at 21.

Thus, under *Sony*, and under the plain language of § 106 of the Copyright Act, those acts of authorization—wholly apart from the Petitioners' other acts—are separate and distinct acts of infringement. *Sony*, 464 U.S., at 435 n.17.

c. Lastly, the Petitioners would have it that NEXIS is an electronic "library" that contains, on its computer disk "stacks" or "shelves" a complete set of the daily editions of the New York Times from the early 1980's to the present, a complete set of the daily editions of Newsday for that period, etc. Pet. Br. 2, 19, 43. And, say Petitioners, a print library can, without any copyright infringement concerns, offer a reader the opportunity to pull down an edition of a newspaper

and thumb directly to a page that the reader knows contains a particular article of interest to her without requiring the reader to go through the paper as a collective whole. Pet. Br. 2. It follows, we are told, that NEXIS can provide the computer display, printout, or download of the same individual article to the same person as a subscriber. Pet. Br. 2, 43. This analogy fails.

The essence of the matter is that a print library cannot, consistent with the Copyright Act, provide readers with a *new copy* of the text material that the reader requests. What a print library can do is allow the interested reader to borrow and return a purchased copy of a copyrighted work bought from the copyright owner. NEXIS in contrast is reproducing and distributing new copies of the author's copyrighted article in providing its subscriber a computer display, printout or download of the work. If ten NEXIS subscribers request the same article, then NEXIS reproduces and distributes ten electronic copies to those subscribers, all of which come from the single article/file stored in its database.

A print library—and in particular any print library reproducing and distributing text materials "for direct or indirect commercial advantage"—can *not* make multiple copies of a copyrighted work in response to reader requests without violating § 108 of the Copyright Act. *See generally* 17 U.S.C. § 108. And the Act's limitations on copying by libraries are particularly restrictive if the library is "engage[d] in the systematic reproduction or distribution of single or multiple copies" of copyrighted works. *Id.*

Petitioners themselves quote with approval from testimony before Congress comparing an electronic database to "a duplicating rather than a circulating library." Pet. Br. at 36 n.24. This accurate characterization, of course, undermines the Petitioners' effort to equate NEXIS with a circulating print library.

Indeed, far from resembling a circulating library, NEXIS more closely resembles the defendant photocopying service found guilty of infringement in *Ryan v. Carl Corp.*, 23 F. Supp. 2d 1146 (N.D. Cal. 1998).

In *Ryan*, the defendant company maintained a list of the titles of millions of individual articles from over 10,000 periodical publishers. The defendant had licensing arrangements with many of the periodical publishers but with none of the authors. The defendant's customers ordered articles from the list; the defendant sent one of its employees to a print, not an electronic, library; and the employee retrieved the periodical issue containing the article from the library's shelves, photocopied the article, and sent the photocopy to the customer. On those facts, the district court held that—even as regards those acts of copying from periodicals published by companies with whom defendant *had* a licensing arrangement—the defendants had engaged in infringement of the rights of the authors. *Id.* at 1150.

Petitioners concede that *Ryan* was correctly decided, as they must, having embraced the proposition that § 201(c) "prevents a publisher from reproducing, revising, or distributing an individual contribution *apart from the remainder of the publication*." Pet. Br. 39 (emphasis added). And Petitioners, thus forced to distinguish the case, can only mutter that in this case "the publishers license the *entirety* of their collective works to NEXIS and UMI," whereas in *Ryan* the licensing arrangements presumably differed. Pet. Br. 33 n. 22.

Putting aside the fact that Petitioners mischaracterize the licenses here, the decision in *Ryan* did not turn on the scope of the copying-service/periodical-publisher licenses in question there, but on the proposition that, whatever rights the periodical publishers had as owners of the collective works copyrights, those rights did not include "the right to

reproduce individual contributions"; instead, "the right of reproduction [of such contributions] must belong to the authors." 23 F. Supp. 2d at 1150.

That principle, which Petitioners profess to embrace, condemns NEXIS' practice of providing computer displays, printouts, and downloads of copies of the Respondents authors' articles as freestanding works.

3. NEXIS, as we have stated, does more than provide computer displays, printouts, and downloads to subscribers of individual articles as freestanding works. The NEXIS system author, subject, keyword and other electronic codes embedded in each article/file enable NEXIS to reproduce and distribute compilations of articles linked by these codes and drawn from multiple periodical issues. The NEXIS system can, for example, provide in response to an author, or "byline," search, a compilation of 98 Stephen Jay Gould articles from twenty-seven different periodicals, or a compilation of the numerous articles on missile defense drawn from myriad periodicals. *Supra* at 5-6.

We have already shown that the § 201(c) "any revision of that collective work" privilege does not permit a periodical publisher to reproduce and distribute a contributed article in a compilation of articles that is an entirely different collective work from the periodical issue in which the article first appeared. *Supra* at 25-27. As we explained, such a compilation is not a revised version of the original periodical issue that included the contribution, but is instead a new and different collective work altogether. *Supra* at 27.

The Petitioners do not offer any argument that these NEXIS "author" and "subject matter" compilations that include a copyrighted article from a particular periodical issue are "a revision of the original periodical issue." Instead the Petitioners claim that NEXIS simply stores many potential revised periodical issues and that when NEXIS in response to

a subscriber request provides an author compilation, that is akin to a library allowing a reader to take the print periodicals off the shelves, turn each to the author's article, and collect the copies in order on a reading room table. Pet. Br. 2, 43.

In analytic terms, this is the same response that the Petitioners offer with regard to the NEXIS reproduction and distribution of individual author-copyrighted articles as freestanding works. And the response is no stronger now than it was the first time.

The Petitioners' response does not, because it can not, explain why an Electronic Publishers' theoretical capacity to provide one compilation of articles excuses the *actual* provision of a different compilation of articles.

And, to the extent that the Petitioners' point is that under *Sony*, only the subscriber, and not LEXIS/NEXIS, is liable for infringement when NEXIS provides the subscriber with a requested computer display, printout, or download of a compilation of articles drawn from multiple collective works, that suggestion is erroneous for the reasons we set out *supra* at 38-39.

Finally, in comparing the NEXIS database to a library shelf, Petitioners again fail to take account of the fact that NEXIS does *not* merely store purchased copies of copyrighted materials; NEXIS reproduces and distributes new copies of the copyrighted materials. *Supra* at 40.

4. As noted, LEXIS/NEXIS also reproduces and distributes author-copyrighted articles every time NEXIS makes an electronic copy of such an article in "promot[ing] to the public"—publishing—a new version, or "generation," of the database in lieu of a previous version of the database. The question implicated by this practice is whether the NEXIS database itself constitutes a "revision" of the

periodical issue in which the copyrighted article first was published.

Here, again, the dispositive point is that the NEXIS database is a compilation of works drawn from multiple collective works and is not a revision of any of the particular collective works that contain the copyrighted freelance articles. Indeed, because as we have emphasized, the individual article/file is the basic component of the NEXIS database, the database is properly characterized as a compilation of the millions of articles that are contained within it. The Register of Copyrights has captured the essence of the matter:

> [B]oth common sense and the dictionary tell us that a database such as NEXIS, which contains every article published in a multitude of periodicals over a long period of time, is not a revision of today's edition of *The New York Times* or last week's *Sports Illustrated.* A "revision" is a "revised version" and to "revise" is "to make a new, amended, improved, or up-to-date version of" a work. ... What makes today's edition of a newspaper or magazine or any other collective work a "work" under the copyright law—its selection, coordination and arrangement—is destroyed when its contents are disassembled and then merged into a database so gigantic that the original collective work is unrecognizable. As the court of appeals concluded, the resulting database is, at best, a "new anthology," and it was Congress's intent to exclude new anthologies from the scope of the § 201(c) privilege. [147 Cong. Rec. at E 183.].

We would add only that what the Periodical Publishers and LEXIS/NEXIS have done here is to disassemble the contents of each periodical issue into *individual article units—viz.*, into the very unit of text in which the author has copyright.

This point makes it all the more clear that NEXIS is precisely the sort of non-privileged "new anthology" of millions of individual articles that the Register has described.

Against this, Petitioners insist that "by no stretch of the imagination, let alone the plain language of the Act and its legislative history, can NEXIS . . . be deemed a new anthology or different collective work," because NEXIS is "simply [a] storage medi[um] on which copies of works reside in electronic versions." Pet. Br. 33-34. In other words, Petitioners suggest that NEXIS is not a "work" at all; they offer no argument for the view that if NEXIS *is* a work, it is a permissible "revision" of any or all of the individual periodical issues that it contains.

But NEXIS *is* a work. Indeed, in Copyright Act terms, NEXIS is both a "literary work" and a "collective work." Under the Act, "'[l]iterary works' are works . . . expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, *disks*, or cards, in which they are embodied." 17 U.S.C. § 101 (emphasis added). Since NEXIS, at any given time, is embodied in a disk or series of disks under some identifier such as "NEXIS Generation 101," it plainly is a "literary work." Moreover, NEXIS is a "collective work" in that it is "a work . . . in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."

That being so, unless the NEXIS database is a "revision" of each periodical issue in which one of Respondents' individually copyrighted works first appeared, it follows that when LEXIS/NEXIS reproduces those articles in "promot[ing]" a new "generation" of the NEXIS database in lieu of a previous version, LEXIS/NEXIS is exceeding the

second § 201(c) privilege. We have already shown that the NEXIS database is *not* such a "revision."[6]

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[6] Given Petitioners' failure to defend the proposition that the database is a revision, we could perhaps end our discussion of this point. However, the District Court in this case concluded that NEXIS *is* a "revision" of each and every periodical issue from which NEXIS draws its articles. Pet. App. 76a. And, in what may be an overabundance of caution, we take the opportunity here to demonstrate the error in that court's approach.

The District Court reached its conclusion through the following syllogism: (1) Under the accepted test for copyright infringement, if author A copies from author B, author A is liable for copyright infringement if author A's work is "substantially similar" to author B's. (2) If a second work is "substantially similar" to the first within the meaning of that test, it must be the case that the second work is a recognizable version of the first work. (3) If a second work is a recognizable version of the first work, it must be a "revision" of the first work.

Applying this syllogism, the District Court stated that had LEXIS/NEXIS electronically published the articles in a particular day's edition of the New York Times (for instance, the December 13, 1991 edition in which one of Respondent Tasini's articles appeared) without securing a license from the Times, LEXIS/NEXIS would clearly be guilty of infringement of the Times' collective works copyright. LEXIS/NEXIS would be guilty even though much of NEXIS—indeed virtually all of NEXIS—is different from the December 13, 1991 Times, because a second work can be "substantially similar" to a first under the infringement test even if *any part* of the second work is substantially similar to the first work. Pet. App. 70a (citing *CCC Information Services v. MacLean Hunter Reports, Inc.*, 44 F.3d 61, 68 n.8 (2d Cir. 1994)). And, the court concluded, because there could be no doubt that *one part* of the NEXIS database—the part constituting the group of articles that originated from the December 13 New York Times—was "substantially similar" to the December 13 New York Times, NEXIS was a "revision" of that edition of the Times. Pet. App. 70a, 74a, 76a.

The fatal flaw in the District Court's reasoning lies in the second step of its syllogism, where the court assumes that if a second work is "substantially similar" to the first for the purposes of determining infringement, it must be the case that the second work is necessarily a

5. Everything that we have said concerning LEXIS/NEXIS' reproduction and distribution of Respondents' works applies with equal force to Petitioner UMI's "New York Times OnDisc" (NYTO) CD-ROM and to its "General Periodicals OnDisc" (GPO) CD-ROM.

a. As set out above, the New York Times OnDisc is a database that is structured identically to the NEXIS database. Like NEXIS, each component article in the NYTO is stored in its own self-contained file and is separately coded with author, subject, and other identifiers that serve to link the article to other article/files sharing the same codes. *See supra* at 10-11. The main difference between NYTO and NEXIS is that the former is a compilation of articles drawn from multiple New York Times newspaper editions, whereas the latter is a compilation of articles drawn from the newspaper editions and periodical issues of numerous publishers.

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recognizable version of the first work. But, because a second work is deemed "substantially similar" to a previous work under the infringement test even if only a *small part* of the second work is similar to a *small part* of the earlier one, the adoption of the infringement test as a test for whether a second collective work is a "revision" of the original collective work leads to total absurdity—to works being labeled as "revisions" that no one would ever call a "revision" in ordinary usage.

For example, in *Harper &. Row Publishers v. The Nation*, 471 U.S. 539, 548 (1985), the Court stated that the use in a nine-page magazine article of 300 words of verbatim or nearly verbatim quotations from a 200,000-word manuscript rendered the magazine article sufficiently similar to the manuscript to constitute an infringement under the accepted test. But that, of course, did *not* mean that the magazine article constituted a "revision" of the manuscript in any ordinary use of that term; it meant only that the *quotations* from the magazine article were substantially similar to the materials being quoted. The reason is straightforward: When one is considering whether a particular work—particularly a collective work—is a "revision" of another, one compares the two works *as collective wholes* and not as disaggregated parts.

That difference, however, has absolutely no legal relevance. The Copyright Act defines "collective work" as "a work such as a "periodical *issue* . . . in which a number of contributions, constituting separate and independent works in themselves are assembled into a collective whole." 17 U.S.C. § 101 (emphasis added). Thus, it is the particular issue of a periodical or the particular edition of a newspaper in which an author-copyrighted article first appears—and not the entire series of periodicals or newspapers put out by a publisher—that constitutes "that collective work" within the meaning of § 201(c). That being so, the New York Times OnDisc, like NEXIS, is a compilation of individual articles drawn from multiple collective works.

For these reasons, it is clear that when NYTO provides a computer display, a printout, or a download of an individual author-copyrighted article, NYTO is "reproducing and distributing" a contributed work as a freestanding work in precisely the same manner as NEXIS. Furthermore, when NYTO provides a display, printout, or download of an author or subject compilation of articles drawn from multiple issues of the paper, it is providing the same kind of "compilation drawn from multiple collective works" as is NEXIS. And lastly, when UMI reproduces and distributes a new copy of a set of the NYTO CD-ROMs, it reproduces and distributes a compilation of articles drawn from multiple collective works that is no different in kind from the compilation LEXIS/NEXIS reproduces and distributes when it electronically publishes a new "generation" of the NEXIS database.

It follows that Petitioners' attempt to justify the foregoing reproduction and distribution practices stands on no firmer ground than their attempt to justify the same practices when engaged in by NEXIS.

b. The General Periodicals OnDisc, like NEXIS, is a compilation drawn from multiple periodicals. And, like

NEXIS, GPO's finding system, as well as its display and printout system, make the *individual article* the basic component of the database and link individual articles to others within the disc system. *See supra* at 12. When a user requests a computer display or printout of, for example, a Mary Kay Blakely article, and that article begins on page 26 of a magazine and jumps to page 76 , the GPO system will print out those two pages and only those two pages. *See supra* at 12. Any fragment of a different article appearing on one of those pages will be printed out only as a fragment, because the GPO system understands that is the Blakely article and only the Blakely article for which a display or printout is being sought.[7]

GPO, like NEXIS and New York Times OnDisc, thus provides displays and printouts of *individual* articles apart from the remainder of the particular periodical issue in which the article appeared. In addition, through its indexing and abstracting system, GPO also provides displays and printouts of compilations of articles organized by subject, topic, and the like. And, finally, given the fact that its internal finding and indexing system is keyed to the *individual article*, the GPO database as a whole is, like NEXIS, a compilation of articles drawn from multiple collective works. All of this being so, the reproduction and distribution of articles and compilations of articles from GPO, as well as the reproduction and distribution of GPO itself, are outside the § 201(c) privilege.

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[7] Petitioners would have it that GPO is no different from a spool of microfilm that contains more than one copy of a periodical issue. Pet. Br. But UMI, in keying each *individual article* in GPO to GPO's indexing, retrieval, display, and printing system, is *disaggregating* the set of images from a given periodical issue contained on the discs so that (as the Mary Kay Blakely example in the text illustrates) the images can be retrieved only as adjuncts to individual articles.

* * * *

All else failing, Petitioners attempt to force a decision in their favor through the hyperbole that "[t]he Second Circuit's decision will have devastating real world effects if it is not reversed," in that "Petitioners and those similarly situated will have no alternative but to destroy any CD-ROM's that contain freelance articles and remove all freelance contributions from electronic libraries." Pet. Br. 49.

Petitioners appear to forget that this case is at the liability stage and not the remedy stage. And, be that as it may, the Register of Copyrights takes a far saner view of the consequences of a ruling in accord with the Copyright Act's precepts and in the Respondents' favor:

> Recognizing that freelance contributions have been infringed does not necessarily require that electronic databases be dismantled. ... The Supreme Court, in *Campbell v. Acuff-Rose Music, Inc.*, [510 U.S. 569 (1994)], and other courts have recognized in the past that sometimes a remedy other than injunctive relief is preferable in copyright cases to protect the public interest. ... Ultimately the *Tasini* case should be about how the authors should be compensated for the publishers' unauthorized use of their works, and not about whether the publishers must withdraw those works from their databases. [147 Cong. Rec. E 183].

There are, of course, multiple arts-and-letters clearinghouse models, including the Publication Rights Clearinghouse, for a joint author-publisher program for assigning proper compensation for the freelance authors whose copyrighted works are being improperly exploited.

CONCLUSION

For the foregoing reasons, the decision below should be affirmed.

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